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| 09/507,613 | 02/21/2000 | James G. Whayne | 15916-229x | 1854 |
| 21836 | 7590 | 08/25/2004 | EXAMINER | |
| HENRICKS SLAVIN AND HOLMES LLP SUITE 200 840 APOLLO STREET EL SEGUNDO, CA 90245 | | | RODRIGUEZ, CRIS LOIREN | |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/507,613
Filing Date: February 21, 2000
Appellant(s): WHAYNE ET AL.

Craig A. Slavin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 13, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 10-21 stand or fall together, and claims 22-37 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------------|--------|
| 6,071,279 | WHAYNE ET AL | 6-2000 |
| 5,439,006 | BRENNEN ET AL | 8-1995 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-12, 15-23, 27-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Whayne et al (US 6,071,279).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

3. Whayne discloses a catheter assembly (figs. 1 and 53) having a handle 18 with a strain relief element 68,336, an elongate catheter body 12,274, a control element 334 secured to the strain relief element 336, and an apparatus (36,26 or 304). Note that in claim 22, the apparatus 304 (located in spaced relation to the handle body) is capable

of securing the proximal portion of the control element 334 in determined relation to the catheter body.

Claim Rejections - 35 USC § 103

4. Claims 13, and 24-26 are rejected under 35 U.S.C. 103(a) as being obvious over Whayne et al in view of Brennen et al (US 5,439,006).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

5. Whayne discloses the invention substantially as claimed. However, Whayne fails to disclose the control element being secured to the strain relief element by a substantially tubular member that surrounds respective portions of the strain relief element and the control element.

Brennen teaches a handle assembly (fig 3) where the control element 12 is secured to the strain relief element 34 by a substantially tubular member 42 that surrounds respective portions of the strain relief element and the control element 12. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Brennen's handle assembly with the Whayne's

catheter assembly. Doing so would have manipulated the control element of the catheter assembly.

(11) Response to Argument

6. Applicant's arguments filed May 13, 2004 have been fully considered but they are not persuasive.

7. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen* 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989).

8. "Claim construction begins with the language of the claims. See *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). In construing patent claims, there is 'a heavy 'heavy presumption' that a claim term carries its ordinary and customary meaning,' *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (quoting *Johnson Worldwide Assocs.*, 175 F.3d at 989), namely its meaning 'amongst artisans of ordinary skill in the relevant art at the time of the invention,' *ResQNet.com, Inc. v. Lansa, Inc.*, 347 F3d 1347, 1378 (Fed. Cir. 2003) (citing *Rexnord*, 274 F.3d at 1342). '[D]ictionaries and treatises may also assist the courts.' *Id.* (citing *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002)); see also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584

n.6 (Fed. Cir. 1996) (noting that ‘[j]udges . . . may . . . rely on dictionary definitions’ to construe claim terms).

9. “A term’s ordinary meaning, however, must be considered in the context of all intrinsic evidence, namely the claims, the specification, and the prosecution history. See Rexnord, 274 F.3d at 1342-43 (explaining that claim terms must be examined in light of the specification and the prosecution history); cf. Gart v. Logitech, Inc., 254 F.3d 1334, 1339-40 (Fed. Cir. 2001) (defining intrinsic evidence). While limitations in the specification must not be routinely imported into the claims because a patentee need not describe all embodiments of his invention, see Rexnord, 274 F.3d at 1344, a definition of a claim term in the specification will prevail over a term’s ordinary meaning if the patentee has acted as his own lexicographer and clearly set forth a different definition, see Tex. Digital Sys., 308 F.3d at 1204 (noting that ‘the inconsistent dictionary definition must be rejected’ if the specification rebuts the presumption of ordinary and customary meaning); Rexnord, 274 F.3d at 1342. ‘This court also considers the prosecution history . . . to determine whether the applicant clearly and unambiguously ‘disclaimed or disavowed [any interpretation] during prosecution in order to obtain claim allowance.’ Middleton, Inc. v. Minn. Mining & Mfg. Co., 311 F.3d 1384, 1388 (Fed. Cir. 2002) (quoting Standard Oil Co. v. Am Cyanamid Co., 774 F.2d 448, 452 (Fed. Cir. 1985)) (alteration in original); see also Omega Eng’g, Inc. v. Raytek Corp., 334 F.3d 1314, 1324 (Fed. Cir. 2003) (noting that ‘the doctrine of prosecution disclaimer’ does not apply ‘where the alleged disavowal of claim scope is ambiguous’).”

10. In response to Appellant arguments with respect to the priority, appellant's priority is based on the effective filing date of US Patent No. 6, 203,525, filed on October 30, 1997 and not from US Patent No. 6,332,880. The **claimed subject matter** in the instant application is disclosed in Patent ('525) and not in the Patent ('880). Furthermore, Patent ('525) is a C-I-P of ('880). See MPEP 201.08.

11. In response to Appellant arguments that the interpretation of the phrase "strain relief element" is unreasonable because (1) it is inconsistent with the specification of the present application and (2) it is inconsistent with the meaning given to the term "strain relief" on other catheter patents, the examiner disagrees. An operator using Whayne's steering mechanism 68 (strain relief element) causes to strain and release the strain of the wire, by applying forces on the proximal end of the wire due the action of the steering mechanism 68. **The broadest reasonable interpretation has been given to the phrase "strain relief element" in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. Pursuant to 35 USC 112, 2nd paragraph, [I]t is applicant's burden to precisely define the invention, and not the [examiner's]." See *In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-29 (Fed. Cir. 1997)*. Therefore, it would not be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the applicant in the written description. Furthermore, it would not be proper for the examiner to allow a claim and issue the application with an examiner's statement of reasons for allowance setting forth the**

special definition given to the words of the claim when no such special definition has been defined by the applicant in the written description.

12. There is one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (See MPEP § 2181- § 2186). The examiner suggests the use of means-plus-function language to give full weight to the specification meaning.

13. Moreover, since the **enlightenment** by way of definitions can be used for interpretation of the claim language, the examiner included with this office action **definitions** of the words "strain" and "relief" to support the examiner's point of view.

The phrase "strain relief element" is a descriptive word and does not impart any specific structure (in the claims) since has not being well described structurally and functionally in the claims with respect and in combination to the other elements.

14. With respect to appellants arguments about the cited references Mahurkar, Kordis, Schweich, and Conley as being non-analogous art in comparison to Whayne and Brennen, the fact that in the abovementioned patents, a particular element has been named "strain relief", does not mean that the name does impart any structural weight in the claims unless it is well defined structurally in both the claims and in the disclosure. A good example would be Wijkamp et al where the strain relief member is the claimed subject matter and is being well defined in both the claims and disclosure.

For the above reasons, it is believed that the rejections should be sustained.

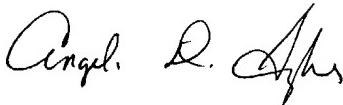
August 23, 2004

Respectfully submitted,


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